

REMARKS

Applicant has carefully studied the Final Office Action of August 24, 2005 and offers the following remarks in response thereto.

Claims 1, 3-7, 9, 10, 12, 14-18, and 20-22 were rejected under 35 U.S.C. § 103 as being unpatentable over Alexander et al. (hereinafter "Alexander") in view of Prohaska. Applicant respectfully traverses. For the Patent Office to combine references, the Patent Office must do two things. First, the Patent Office must state a motivation to combine the references, and second, the Patent Office must support the stated motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Once a proper combination is made, to establish *prima facie* obviousness, the Patent Office must show where each and every element of the claim is taught or suggested in the combination of references. MPEP § 2143.03.

In the response to the Final Office Action of June 15, 2005, Applicant previously argued that the Patent Office had not provided evidence to support the motivation to combine the references. The Patent Office responds to Applicant's arguments on page 6 of the Office Action of August 24, 2005. Specifically, the Patent Office argues that Alexander teaches a number of different arrangements and thus "Alexander can have another alternative arrangement." (Office Action of August 24, 2005, page 6, lines 18-19). The Patent Office states that it would have been obvious "to incorporate the wavelength select switch taught by Prohaska into the system of Alexander for the wavelength select switch." (Office Action of August 24, 2005, page 7, lines 1-2). However, the evidence offered by the Patent Office only proves that Alexander contemplated another embodiment, not that Alexander desired the switch of Prohaska. To date, the Patent Office has provided no evidence why someone of ordinary skill in the art would substitute Prohaska's switch into Alexander's system. Merely because a combination is possible is insufficient to establish obviousness. MPEP § 2143.01. Absent the requisite evidence, the combination of Alexander and Prohaska represents impermissible hindsight reconstruction. Since the combination is improper, the rejection based on the combination is improper. Since the rejection is improper, the claims are allowable. Applicant requests withdrawal of the § 103 rejection of claims 1, 3-7, 9, 10, 12, 14-18, and 20-22 at this time.

Applicant further argued that the combination of Alexander and Prohaska did not teach "passing a subset of the optical signals through the wavelength select switch at substantially the same time; and measuring power in the subset of optical signals using the power meter" as recited in the claims. The Patent Office responds that "the unselected 'subset' wavelengths are also output from the device through another output port." (Office Action of August 24, 2005,

page 7, lines 7-8). The Patent Office further asserts that "it would be obvious for one of ordinary skill in the art at the time when the invention was made to measure the output power of the subset of wavelengths." (Office Action of August 24, 2005, page 7, lines 8-10). This conclusion drawn by the Patent Office does not follow from the evidence of record. The claims require that the subset that is passed through the switch have the power measured. Prohaska only measures the single wavelength, as argued in the Response filed July 26, 2005. Measuring the power of a single wavelength is not the same as measuring the power of a subset as recited in the claims. The Patent Office must modify the teachings of one or both references to go from measuring a single wavelength (Prohaska) to measuring the power of a subset as recited in the claims. For the Patent Office to modify a reference in a combination, the Patent Office must provide evidence that suggests the modification to the reference. *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000); *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992). Here, the Patent Office has not provided any motivation as to why someone would modify Prohaska's device to measure power for the unselected signals. Likewise, the Patent Office has not provided any evidence to support the motivation to modify the reference. As such, this implied modification to Prohaska is improper. Absent the modification, the combination does not teach or suggest the recited claim element. Since the combination does not teach or suggest the recited claim element, the combination does not establish *prima facie* obviousness. Applicant requests withdrawal of the § 103 rejection of claims 1, 3-7, 9, 10, 12, 14-18, and 20-22 on this basis as well.

Previously, Applicant separately argued claims 6 and 17, stating that Alexander did not show a dense wavelength division multiplexing system as recited in the claims. The Patent Office responds on page 6 of the Office Action of August 24, 2005 by stating that the Patent Office has not given the recitation patentable weight because the recitation is in the preamble of the claims. This assertion is demonstrably false. The recitation clearly takes place after the transition term "comprises", which means that the recitation is in the body of the claim, not the preamble as asserted by the Patent Office. Since this assertion is the Patent Office's only response to Applicant's arguments, the Patent Office effectively admits that the claim element is not shown by the references. Since the combination does not teach or suggest the claim element, the combination does not establish *prima facie* obviousness for the claims. Applicant requests withdrawal of the § 103 rejection of claims 6 and 17 on this basis.

Claims 11 and 23 were rejected under 35 U.S.C. § 103 as being unpatentable over Alexander in view of Prohaska and further in view of Fujiwara et al. (hereinafter "Fujiwara"). Applicant respectfully traverses. The standards for establishing obviousness are set forth above.

Applicant previously argued the points raised above and that the Patent Office had not provided the appropriate evidence to combine Fujiwara with Alexander and Prohaska. The Patent Office responds on page 7 of the Office Action of August 24, 2005 that Fujiwara shows that it is known to regulate an optical amplifier and that it would be obvious to incorporate Fujiwara into the Alexander to control the gain of the optical amplifier. Again, the Patent Office lacks any evidence about why the artisan would be motivated to combine the references. That is, the Patent Office has not provided any evidence as to why the artisan would feel the need to regulate the gain of the optical amplifier. Merely because a combination is possible does not mean that the combination is suggested. MPEP § 2143.01. In the absence of the requisite actual evidence, the combination is improper. Since the combination is improper, the rejection based on the combination is improper. Since the rejection is improper, claims 11 and 23 are allowable for this reason as well.

Applicant requests reconsideration of the rejections in light of the remarks presented herein. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

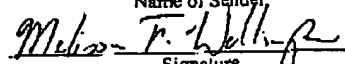
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Date: September 16, 2005

Attorney Docket: 7000-209

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